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In re Application of :  
GIERSCHIK, Thomas, et al. :  
U.S. Application No.: 10/527,714 :  
PCT No.: PCT/EP03/10173 :  
International Filing Date: 12 September 2003 :  
Priority Date: 13 September 2002 :  
Attorney's Docket No.: 449122080300 :  
For: COMMUNICATIONS NETWORK PLANNING :  
SYSTEM, METHOD FOR CREATING :  
COMMUNICATION NETWORKS DIAGRAMS :  
AND CONTROL PROGRAM FOR A :  
COMMUNICATIONS NETWORK PLANNING :  
SYSTEM :  
: COMMUNICATION  
: REGARDING SUBMISSION  
: UNDER 37 CFR 1.42

This communication is issued in response to applicants' submission on 06 January 2006 of a declaration apparently executed on behalf of deceased inventor Rudolf KUCHLER by his heirs, which has been treated as a submission under 37 CFR 1.42.

**BACKGROUND**

On 12 September 2003, applicants filed international application PCT/EP03/10173. The application claimed a priority date of 13 September 2002 and designated the United States. On 01 April 2004, the International Bureau ("IB") communicated a copy of the international application to the United States Patent And Trademark Office ("USPTO"). The deadline for payment of the basic national fee was 13 March 2005 (thirty months from the priority date).

On 11 March 2005, applicants filed a transmittal letter for entry into the national stage in the United States accompanied by, among other materials, payment of the basic national fee and a translation of the international application into English.

On 08 November 2005, the United States Designated/Elected Office (DO/EO/US) mailed a "Notification Of Missing Requirements (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497 and the surcharge for filing the oath or declaration later than thirty months after the priority date were required.

On 06 January 2006, applicant filed a response to the Notification Of Missing Requirements that included the surcharge payment and a declaration form. The declaration was

executed by applicant Thomas GIERSCHIK and on behalf of the deceased sole inventor Rudolf KUCLER by two persons identified as heirs, Helmut KUCHLER and Maria KUCHLER. This declaration is considered herein under 37 CFR 1.42 and 1.497.

### DISCUSSION

37 CFR 1.42 *When the Inventor is Dead*, states, in part:

In case of the death of the inventor, the legal representative (executor, administrator, etc.) of the deceased inventor may make the necessary oath or declaration, and apply for and obtain the patent.

Section 409.01(a) of the Manual of Patent Examining Procedure (MPEP) states that the application can also be executed by all of the heirs of the deceased inventor, where no legal representative has been appointed or is required to be appointed by law.

37 CFR 1.497(b)(2) states the following:

(2) If the person making the oath or declaration or any supplemental oath or declaration is not the inventor (§§ 1.42, 1.43, or § 1.47) the oath or declaration shall state the relationship of the person to the inventor, and, upon information and belief, the facts which the inventor would have been required to state. If the person signing is the legal representative of a deceased inventor, the oath or declaration shall also state that the person is a legal representative and the citizenship, residence, and mailing address of the legal representative.

Pursuant to 37 CFR 1.497(b)(2), the citizenship for **both** the deceased inventor and the legal representative must be identified on the declaration (as well as the mailing address and residence information of the legal representative and all other information required under 37 CFR 1.497).

Here, the declaration filed 06 January 2006 includes the required citizenship, residence, and mailing address information for the surviving inventor, the deceased inventor, and the persons signing the declaration on behalf of the deceased inventor. However, the two persons executing the declaration on behalf of the deceased inventor are identified only as "heirs." Neither the declaration, nor any materials submitted therewith, state that these two persons are the only heirs of the deceased inventor. Before the declaration may be accepted under 37 CFR 1.42, applicants must provide an acceptable statement and/or supporting documentation confirming that these are the only heirs of the deceased inventor.

In addition, the declaration does not comply with 37 CFR 1.69 in that it has not been fully translated into English. The translation of the body of the declaration is acceptable since applicants have used the German-English declaration form provided by the USPTO (Form

PTO/SB/103); however, the title of the application is listed in German on both the German side of the declaration form and the English side. Pursuant to 37 CFR 1.69(b), applicants must provide a translation of the title of the declaration, together with a statement that the translation is accurate, no later than two months from the date of this Communication.

### CONCLUSION

For the reasons discussed above, the request for status under 37 CFR 1.42 is **DISMISSED** without prejudice.

Applicants have **TWO (2) MONTHS** from the mailing date of this communication to submit a proper response under 37 CFR 1.42 and 37 CFR 1.497. Failure to provide a proper and timely response will result in abandonment.

A proper response must include an adequate statement and/or supporting documentation confirming that Helmut KUCHLER and Maria KUCHLER are all the heirs of the deceased inventor, and an English translation of the title of the application (set forth only in German on the declaration) together with a statement that the translation is accurate.

Any further correspondence with respect to this matter should be addressed to Mail Stop PCT, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration



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